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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,842

Applicant(s)

JOHNSON ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit 1711

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 20 and 29-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kuzuhara et al. (JP 10292084).

See the previous Office action at page 3 line 9 et seq.

Claims 1, 20 and 29-35 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Furuta et al. (JP 11322812).

Art Unit 1711

See the previous Office action at the last complete paragraph on page 4 et seq.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending application Serial No. 09/579,843. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the method of cross-linking using moisture is not recited by the co-pending application, the co-pending application recites that the material produced is cross-linkable by hydrolysis and therefore it would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to cross-link the material of the co-pending application to provide the benefit accruable known to those skilled in the art upon

Art Unit 1711

cross-linking absent any showing of surprising or unexpected results.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' arguments filed 5-9-03 have been fully considered but they are not deemed to be persuasive.

Applicants are reminded that the "Other Prior Art" on applicants' Information Disclosure Statement which has been crossed out have not been considered as set out in the previous Office action.

With regard to Kuzuhara, applicants argue that in contrast to Kuzuhara the present invention uses a non-derivatized polyethylene oxide of 2000-200,000 ethylene oxide units based on a molecular weight of 100,000-10,000,000. However no such limitation appears in the claims and limitations from the specification are not read into unpatented claims. With regard to applicants' arguments that Kuzuhara prepares two polymers sequentially and that the PME 400 functions as a dispersion stabilizer and that a second copolymer is prepared which has the methacryl alkoxysilane along with a substantial amount of hydrophobic monomers, the Examiner agrees. However none of these facts are inconsistent with the Examiner's position regarding the teachings of Kuzuhara. Applicants argue that Kuzuhara's

Art Unit 1711

materials are resistant to water and humidity and that such resistance is imparted from the substantially hydrophobic coating that forms. However there is nothing in the claims which is pertinent to applicants' allegation regarding the "hydrophobic coating" alleged to be formed by Kuzuhara except possibly with regard to applicants' characteristic that their materials are capable of absorbing a quantity of aqueous liquid. However since no lower limitation of water absorption is recited by the claims, even a miniscule amount of water absorption such as by a material with little hydrophilicity would meet the limitations of the claims. Furthermore with regard to the water resistance of Kuzuhara, such water resistance would be inherent in any cross-linked material given that a cross-linked material cannot dissolve in water or any other material. Applicants argue that "(T)he probability of methacryl alkoxysilane grafting onto the very small amount of poly(ethylene oxide) side chain is extremely low since there is a much higher concentration of vinyl monomers present for methacryl alkoxysilane to react with". While this may well be true there is no lower level of grafting recited in the claims and even a miniscule amount of grafting meets the limitation of the claims. With regard to applicants' argument that the PME 400 is used to stabilize the dispersion, this of course is true. However grafting is generally conducted in the art by contacting polymers with monomers in the presence of a

Art Unit 1711

free radical initiator and therefore it reasonably appears that at least a small amount of grafting would take place. It is not, nor has it ever been the position of the Examiner that cross-linking takes place during polymerization of the monomeric components of Kuzuhara but rather that cross-linking takes place later when the finished material is contacted with moisture and humidity. The Examiner has reviewed the structures and reaction schemes shown in applicants' arguments regarding Kuzuhara. However it is not, nor has it ever been the position of the Examiner that the comb polymer on page 10 of applicants' remarks meets the limitation of the claims.

With regard to Furuta, applicants argue that the polyethylene oxide component present in Furuta is part of a surfactant and is used as a dispersion stabilizer and therefore the polyethylene oxide component of Furuta et al. is a surfactant, not a polymer. However the terms "surfactant" and "polymer" are not mutually exclusive. A material containing plural repeat units such as in the instant case repeat ethylene oxide units is a polymer and therefore the polyethylene oxide component of Furuta is a polymeric surfactant.

With regard to the rejections under 35 U.S.C. § 103, applicants renew their arguments pertaining to the rejections under 35 U.S.C. § 102. However the Examiner's response to applicants' arguments is the same as those above.

Art Unit 1711

With regard to the obviousness-type double patenting rejection of the instant claims over claims 1-29 of co-pending Application Serial No. 09/579,843, applicants are requested to point out their basis in Office policy for their allegation that no response to a provisional rejection is required. If applicants are intending to argue that no response to a provisional rejection is required merely because an application has not issued as a patent, this is always the situation when a provisional double patenting rejection is made. A double patenting rejection, not a provisional double patenting rejection is made once an application claims are patented. The Examiner agrees that claims 2-9 and 21-28 are allowable except with regard to the provisional double patenting rejection.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED

Art Unit 1711

STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

July 24, 2003

Primary Examiner
Art Unit 1711

